

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated June 3, 2009, (hereinafter Office Action) have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the § 103(a) rejections, each of which is based upon the teachings of U.S. Publication No. 2005/0099984 by Alakoye *et al.* (hereinafter “Alakoye”), because Alakoye has not been shown to be “prior” art with respect to the instant application. Notably, the filing date of Alakoye is subsequent to the filing date of the instant application. While Alakoye claims priority to a provisional application filed on November 7, 2003, in order to rely on that provisional filing date for the purposes of a prior art-based rejection, the provisional Alakoye application (Prov. No. 60/517,896) needs to properly support the subject matter relied upon in Alakoye. *See*, MPEP § 2136.03(III) (8th ed., rev. 7, July 2008). However, the Office Action fails to demonstrate, or even assert, that the relied-upon teachings are properly supported by the Alakoye provisional application as required.¹

In general, Alakoye does not directly correspond to the provisional Alakoye application such that support for the citations to Alakoye is not readily identifiable. However, a review of the brief disclosure of the Alakoye provisional application does not identify the requisite support for at least the discussion in cited paragraph [0029] of Alakoye. Without a presentation of proper support in the Alakoye provisional application for each of the relied-upon teachings of Alakoye, Alakoye cannot be afforded the benefit of the provisional filing date for those teachings. Thus, Alakoye has not been shown to be

¹ *See, e.g.*, Ex parte Nobuhiko Ota, Toshikazu Hamao and Yoshifusa Tsubone, 2006 WL 2851414 (Bd.Pat.App. & Interf.), providing an example where the Board of Patent Appeals remanded an application to the Examiner to “explain how and where that provisional application supports, in the manner provided by § 112, first paragraph the subject matter of the relied upon Gabrys’ patent invention such that a § 102(e) date based on that earlier provisional application filing may be accorded the Gabrys’ patented subject matter relied upon by the Examiner in rejecting the claims.”

“prior” art upon which a § 103(a) rejection of the pending claims could be based.

Therefore, each of the rejections is improper, and Applicant accordingly requests that each of the rejections be withdrawn.

Moreover, consistent with the acknowledgement at pages three and six of the Office Action, Applicant maintains that U.S. Patent No. 7,031,746 to Na *et al.* (hereinafter “Na”) fails to teach at least requesting for suspension of a data streaming communication from a server on the basis of a first mode change command, as claimed in each of the independent claims. Instead, Na teaches that when a voice call request is detected, reception of the multimedia broadcast is continued, but the decoding of the audio signal of the received multimedia broadcast is discontinued for the duration of the voice call (Figs. 2, 3, 4, 5, blocks 221, 315, 431, 519). While the receiving device discontinues decoding the audio signal of the received broadcast, the broadcast signal is still received and the video portion is viewed during the voice call (*e.g.*, Col. 1, line 59 – Col. 2, line 10 and Col. 8, lines 54-63). Thus, in direct contrast to the claimed invention, Na continues to receive and process the digital multimedia broadcast despite a voice call being accepted/initiated (asserted as corresponding to the claimed first mode change command generated by the user). Moreover, Na is directed to operations internal to the mobile terminal and does not suggest sending a message to a server, as claimed. Since Alakoye has not been qualified as prior art and Na fails to teach or suggest at least these claim limitations, any combination of the teachings of Na with those of Alakoye would not properly correspond to such limitations. Thus, the § 103(a) rejections cannot be maintained. Applicant accordingly requests that the rejections be withdrawn.

Further, Applicant traverses each of the § 103(a) rejections because the asserted modification of Na would improperly undermine the teachings of Na. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V). As explained above, Na is directed to a device that receives a multimedia broadcast during the existence of a voice call to allow a user to continue to view the

broadcast video/text while taking the voice call. Modifying the device of Na to instead suspend the multimedia broadcast would directly undermine the objective of allowing Na's user to view the broadcast while taking/making a voice call. Since the asserted modification undermines the objective of Na, such a modification cannot support the § 103(a) rejections. Applicant accordingly requests that each of the § 103(a) rejections be withdrawn.

Dependent Claims 2-8, 10-16, 18-24, and 26-28 depend from independent Claims 1, 9, and 17, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed combination of Na and Alakoye. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with the independent claims above. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-8, 10-16, 18-24, and 26-28 are also patentable over the asserted combination of Na and Alakoye.

With particular respect to the rejection of dependent Claim 19, the continued references to Xiang and Walker are improper as they are inconsistent with the statement of rejection at page five. Applicant is of the understanding that these references were again inadvertant and the rejection is instead based upon the teachings of Na and Alakoye. If this understanding is incorrect, Applicant requests clarification and an opportunity to respond.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, non-functional limitations, intended use, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the

right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

In addition, Claim 12 has been amended to remove reference numerals from the claim. These changes are not made for any reasons related to patentability or the asserted references and do not introduce new matter. Therefore, this claim with, or without, the changes is believed to be patentable over the asserted references for the reasons set forth above.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.101PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8500 Normandale Lake Blvd., Suite 320
Minneapolis, MN 55437
952.854.2700

Date: September 1, 2009

By: /Erin M. Nichols/

Erin M. Nichols
Reg. No. 57,125